



A DOCPHOENIX

## APPL PARTS

|                       |
|-----------------------|
| IMIS                  |
| Internal Misc. Paper  |
| LET.                  |
| Misc. Incoming Letter |

371P  
PCT Papers in a 371 Application

A...  
Amendment Including Elections

ABST  
Abstract

ADS  
Application Data Sheet

AF/D  
Affidavit or Exhibit Received

APPENDIX  
Appendix

ARTIFACT  
Artifact

BIB  
Bib Data Sheet

CLM  
Claim

COMPUTER  
Computer Program Listing

CRFL  
All CRF Papers for Backfile

DIST  
Terminal Disclaimer Filed

DRW  
Drawings

FOR  
Foreign Reference

FRPR  
Foreign Priority Papers

IDS  
IDS Including 1449

NPL  
Non-Patent Literature

OATH  
Oath or Declaration

PET.  
Petition

RETMAIL  
Mail Returned by USPS

SEQLIST  
Sequence Listing

SPEC  
Specification

SPEC NO  
Specification Not in English

TRNA  
Transmittal New Application

3/1/02 CTNF 6  
Count Non-Final

CTRS  
Count Restriction

EXIN  
Examiner Interview

M903  
DO/EO Acceptance

M905  
DO/EO Missing Requirement

NFDR  
Formal Drawing Required

NOA  
Notice of Allowance

PETDEC  
Petition Decision

## OUTGOING

|                     |
|---------------------|
| CTMS                |
| Misc. Office Action |

1449  
Signed 1449

892  
892

ABN  
Abandonment

APDEC  
Board of Appeals Decision

APEA  
Examiner Answer

CTAV  
Count Advisory Action

CTEQ  
Count Ex parte Quayle

CTFR  
Count Final Rejection

## INCOMING

AP.B  
Appeal Brief

C.AD  
Change of Address

N/AP  
Notice of Appeal

PA..  
Change in Power of Attorney

REM  
Applicant Remarks in Amendment

XT/  
Extension of Time filed separate

BACKFILE DOCUMENT INDEX SHEET

### Internal

SRNT  
Examiner Search Notes

CLMPTO  
PTO Prepared Complete Claim Set

ECBOX  
Evidence Copy Box Identification

WCLM  
Claim Worksheet

WFEE  
Fee Worksheet

### File Wrapper

FWCLM  
File Wrapper Claim

IIFW  
File Wrapper Issue Information

SRFW  
File Wrapper Search Info

6/26/03



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/807,458      | 07/05/2001  | Carmen Almansa       | 1604-129            | 7335             |

6449 7590 12/31/2002

ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
1425 K STREET, N.W.  
SUITE 800  
WASHINGTON, DC 20005

EXAMINER

SAEED, KAMAL A

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/807,458

Applicant(s)

ALMANSA ET AL.

Examiner

Kamal A Saeed

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 20-40 is/are pending in the application.
- 4a) Of the above claim(s) 30-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 20-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 1, 4, and 10-12 have been amended. Claims 14-19 are have been cancelled by amendment and claims 23-40 have been added by amendment. Therefore, claims 1-13 and 20-40 are currently pending in this application. Claims 1-13 in part and claims 30-40 are withdrawn from further consideration to 37 CFR 1.142(b) as being drawn to non elected subject matter.

Receipt is acknowledged of Amendment B, filed september 30/2002, which has been entered in the file.

### ***Response to Restriction***

Applicant's election with traverse of Group I, directed to compounds of formula I, wherein R<sub>2</sub> is phenyl or naphthyl, the method of preparing the compounds and a method for treating diseases mediated by cyclooxygenase in paper No. 3 is acknowledged. The traversal is on the ground(s) that each of the elected Group could be extended to other groups without imposing an undue burden on the Examiner. This is not found persuasive because each of the various Groups is directed to art recognized compounds and processes which are different from each other and, are capable of supporting their own patents. Moreover, the examiner is required to conduct a commercial data base search on each invention which is extremely burdensome.

Therefore, the restriction requirement in paper No. 2 as amended is deemed proper and made FINAL.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicants preserve their right to file a divisional on the non-elected subject matter.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a), which forms the basis for all obviousness rejections, set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 and 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weir et al. WO 9603387.

Applicants claim imidazole compounds with anti-inflammatory activity.

*Determination of the scope and content of the prior art (MPEP §2141.01)*

Weier et al teach 4,5-substituted imidazolyl compounds and their use as anti-inflammatory agents.

*Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)*

Broadly, the compounds taught by Weier et al are isomers of applicant's claims wherein **R<sub>1</sub>** is methyl, **R<sub>2</sub>** is halogen substituted phenyl, **R<sub>3</sub>** is C<sub>1-8</sub> alkyl, **X** is C and **Y** is N (See CAS ABSTRACT RN# 177755-75-8 and 177755-76-9). One of the difference between the claimed compounds and that of the reference herein lie in that these compounds are positional isomers i.e. the position of attachment of the halogen substituted phenyl group in the prior art is through carbon ( see CAS ABSTRACT RN 212630-39-2, 212630-38-1, 212630-40-5, Copy attached)

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while this application teaches a N-attachment of the substituted phenyl ring. The claimed compounds are so closely related structurally to the compounds of the reference as to be structurally obvious, in the absence of any unobviousness or unexpected properties. Nothing unobvious is seen in substituting the known claimed isomer for the structurally similar isomer, as taught by Bridges et al, since such structurally related compounds suggest one another and would be expected to share common properties absent a showing of unexpected results. In re Norris, 84 USPQ 458 (1950).

*Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)*

Wieier et al are analogous art because Weier et al compounds possess similar activity. One skilled in the art would expect that the instant claims which are isomers to the Wieier compounds i.e. C-attachment of halogen substituted phenyl group Vs N-attachment of halogen substituted phenyl group, prima facie. The motivation to make claimed compound derives from the expectation that structurally similar compounds are generally expected to have similar properties and have similar utilities. In re Gyurik, 596 F. 2d 1012, 201 USPQ 552 (CCPA 1979). The explicit generic teaching of Wieier et al together with the enabled examples with variations in the position of attachment of the halogen substituted phenyl group would have motivated one skilled in the art to modify the known compounds with such generic teaching with the expectation that they would all have similar activity as taught by Wieier et al.

***Claim Objections***

Claims 1-13 are objected to for containing non-elected subject matter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal Saeed whose telephone number is (703) 308-4592. The examiner can normally be reached on Monday-Friday from 8:00 AM – 5:00 PM.